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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,002	10/30/2003	Shinobu Sakurada	1300-000008	7421

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EXAMINER

DIXON, MERRICK L

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/698,002	Applicant(s) SAKURADA ET AL.	
	Examiner Merrick Dixon	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

MERRICK DIXON
PRIMARY EXAMINER

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2

Claims 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 2 of copending Application No. 10/787895. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Any additional rings are inherent for the material are identical.

3

Claim 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 3 are of copending Application No. 10/508479. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

All additional rings are inherent for the material are identical

4

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by JP-2001-75,297.

The reference teaches a liquid crystal compound having charge transfer property and ferroelectricity. The reference 's crystal compound has $>1 \times 10^{-5} \text{ cm}^2/\text{V}\cdot\text{sec}$ positive hole mobility. The reference further teaches that the liquid crystal has 6 pi electron-based aromatic group, L, 10 pi electron based aromatic group, M, and/or 14 pi electron base aromatic group, N, cores. Where $L+M+N=1$ to 4. Each of L, M and M is integers)-4. Further, the liquid crystal compound has 2-phenyl naphthalene ring . In section [0011] of the reference, the core includes phenylnaphthallene , biphenyl, benzothiazole and t-thiophene with side chain of alkyl or alkoxy group as required by claim 3.

6

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2001-33,990. The reference teaches a photoconductive layer composed of an organic semiconductor liquid crystalline and dielectric layer on electrodes . the reference 's liquid crystal compound has $>1 \times 10^{-5} \text{ cm}^2/\text{V}\cdot\text{sec}$ electron mobility and $>1 \times 10^{-5} \text{ cm}^2/\text{V}\cdot\text{sec}$ positive hole mobility. The reference teaches liquid crystal compound , with 6 pi electron based aromatic group, L. M, 10 pi electron based

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aromatic group. N, 14 pi electron based aromatic group. $L+M+N=1-4$. Such inclusions would cause the material to behave in similar manner as claimed and required by claims 2 and 3. See section [0010] of the reference. Also, see sections [0016-0017].

7

Applicant's arguments filed 2-16-06 have been fully considered but they are not persuasive. Applicants argue that the 101 rejection is improper because the claims are not identical. The examiner disagrees as the patent discloses angles within such claimed angle ranges. Applicants further argue that the claimed phase angle was determined at a specific impedance of desired frequencies range. To this the examiner respectfully remind applicants that the office is in no position to experimentally determine a phase angle such at issue. In such instance, this shifts the burden to applicants who have the resource to experimentally and define the differences between the cited reference and the instant claimed language.

8

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9

Applicants who wish to send a facsimile (draft copies) for the examiner's immediate review can do so by using the Examiner's personal fax number at 571-273-1520. The faxing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 (November 15, 1989). **NOTE: All facsimiles sent to the examiner's personal fax number should be in draft-forms and will be treated as informal.**

Same facsimiles will not be entered in the related applications unless otherwise agreed and noted by the examiner.

The fax number for all other fascimile is 571-273-8300.

Information about **the status of an application** may be obtained from the Patent Information Retrieval system (**Private PAIR**).

Status inquires for **published applications** may be retrieved from either **Private PAIR** or **Public PAIR**. Questions about the PAIR system should be directed to the Electronic Business Center at **866-217-9197**.

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Any questions concerning the instant communication should be directed to Examiner
Dixon, at 571-272-1520, Mondays, Wednesdays and Thursdays, between 12 noon and
8 PM, eastern time .

A handwritten signature in black ink, appearing to read 'Merrick Dixon', with a stylized, cursive script.

Merrick Dixon

Primary Examiner

Group 1700